



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,911	10/22/2003	Koichi Maari		6383
530	7590	02/11/2008	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			OBEID, MAMON A	
ART UNIT	PAPER NUMBER			
		3621		
MAIL DATE	DELIVERY MODE			
02/11/2008	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/690,911	Applicant(s) MAARI, KOICHI
	Examiner MAMON OBEID	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 19 November 2007.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 38-47 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 38-47 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/DS/02)

Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) Notice of Informal Patent Application

6) Other: _____

DETAILED ACTION

Status of Claims

1. This is in reply to amendment filed on November 11, 2007.
2. Claims 38 and 43 have been amended.
3. Claims 38- 47 are currently pending and have been examined.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 38- 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al, US Patent No. 5,892, 900 ("Ginter"), in view of Stefik et al, US Patent No. 5,629,980, ("Stefik").

5. **As per claim 38:** Ginter discloses the following limitations:
 - receiving content from a content provider (figures 77-84; column 313, lines 38-56) and encrypting the content with a content key (figures 17-20; column 223, lines 5-13; column 312, lines 37-43; column 313, lines 38-56).

- generating use conditions including a content ID and a user ID (figures 19 and 26A, item 940; column 134, lines 29-38; column 155, lines 38-51; column 158, lines 58-65; column/line 159/12-160/33; column 215, lines 4256; column 299 lines 4549; column 311 lines 1234; column 312 lines 37-43).
- transmitting the encrypted content having the content ID added thereto to a content server (column/line 307/4308/43; column 309 lines 5860; column 314 lines 1024; column/line 315/26 316/5).
- transmitting the encrypted content stored in the content server, the content key and use condition through a user terminal to a player in response to a request from a user (figures 2 2A and figures 79- 84; column 62 lines 31-50 and 52-64; column 137 lines 35-50).

Ginter does not explicitly disclose transmitting the encrypted content, the content key and the usage condition to a player through the user terminal, however, Stefik clearly discloses a rendering repository 203 (see at least figure 2 and column 3, line 50- column 4, line 35) which receives the encrypted digital work, an encryption key and a set of rights associated with the digital work (see at least column 37 line, 37- column 38, line 50).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ginter's teachings to include the step of

transmitting encrypted digital work, encryption key and the associated usage rights to a rendering system/ player disclosed by Stefik to maintain the security and integrity of the system by storing the digital work within a repository and attaching permanently to the digital work the associated usage rights and fees, See in Stefik (column 6, line 19- column 7, line 5).

6. **As per claim 39:** Ginter discloses *generating the content key* (column 214, line 3- column 216, line 4).
7. **As per claim 40:** Ginter discloses *compressing the encoded digital content* (column 68 lines 43-59).
8. **As per claim 41:** Ginter discloses *encrypting the content key* (figure 19; column 135 lines 51- 59; column 137 lines 35-50 and 57-64).
9. **As per claim 42:** Ginter discloses *executing a process to share a session key with the user and encrypting the use condition with the session key* (figure 19; column155 line 37- column 156, line 14; column 207 lines 20- 33; column 222 lines 40-50).

10. **As per claims 43- 47:** the claims recite an apparatus for performing the method of claims 38- 42 and hence, they are rejected under the same reasoning as used in the rejections of claims 38- 42 shown above.
11. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.
12. Although Applicant(s) use "means for" in the claim(s) (e.g. claims 43- 47), it is the Examiner's position that the "means for" phrase(s) do not invoke 35 U.S.C. 112 6th paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of "means for" from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6th paragraph should not be invoked.
Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6th paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6th paragraph, the "means for" phrase(s) will be interpreted as set forth in the *Supplemental*

Examination Guidelines for Determining the Applicability of 35 USC 112 6th (See

Federal Register Vol. 65, No 120, June 21, 2000).

Failure by Applicant(s) in their next response to also address the 35 U.S.C. 112 6th paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6th paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6th paragraph applies to all examined claims currently pending.

Response to Arguments

13. Applicant's arguments with respect to claims 38 and 43 have been considered but are moot in view of the new ground(s) of rejection.
14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - "DigiBox: A Self-Protecting Container for Information Commerce", by Olin Sibert, David Bernstein, and David Van Wie and published in the Proceedings of the First USENIX Workshop on Electronic Commerce New York, New York, July 1995, discloses a Digibox container for seamlessly packaging information and controls to enforce information use rights.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mamon Obeid whose telephone number is (571) 270-1813. The examiner can normally be reached on Mon-Fri 9:30 AM- 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mamon Obeid
Examiner
Art Unit: 3621
February 10, 2008

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621